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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,590	10/25/2006	Keith Clark	03-0009/US1 (8470-69/NPB)	6065
29293 7590 03/30/2009 FREUDENBERG-NOK GENERAL PARTNERSHIP LEGAL DEPARTMENT 47690 EAST ANCHOR COURT PLYMOUTH, MI 48170-2455				
EXAMINER PATEL, VISHAL A				
ART UNIT 3676		PAPER NUMBER		
NOTIFICATION DATE 03/30/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/553,590

Applicant(s)

CLARK, KEITH

Examiner

Vishal Patel

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008 and 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/08 has been entered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5 and 7, drawn to a unitized pinion seal, classified in class 277, subclass 551.
 - II. Claim 6, drawn to a method of installing a pinion seal to a carrier/bearing cage and an axle companion flange, classified in class 384, subclass 147.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the method described in group II can be used to assembly a mechanical face seal (e.g. 4,136,885).

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to

petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Ryan Massey on 3/22/09 a provisional election was made without traverse to prosecute the invention of group I, claims 1-5 and 7. Affirmation of this election must be made by applicant in replying to this Office action. Claim 6 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim

5, "a second retainer ring", unclear what member this refers to in view of the specification. The retainer does not have a second retainer ring described in the specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, "a first retaining ring engaging said sleeve prior to assembly of said unitized pinion seal to said first member", unclear if this is the same member that is engaging the sleeve in claim one or a different member (if different member, this member is not shown in the figures or described in the specification). For examination purpose the first retainer ring is the same as the first axially extending portion in the form of a ring.

Claim 5, "said retainer portion", this limitation is unclear in view of the limitations "retainer" in claims.

Claim 5, "a second retainer ring", unclear what member this refers to in view of the specification. The retainer does not have a second retainer ring described in the specification.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Angelo et al (US. 6,170,992).

Angelo discloses a unitized pinion seal in an assembled state, the unitized pinion seal having a sleeve (e.g. 19) including a first axially extending ring portion (e.g. 21) covered with an elastomeric seal layer, a radially extending portion (e.g. 22) extending radially outward from an end of the first axially extending ring portion and a second axially extending ring portion (e.g. portion having 24 and 57) extending axially from a radially outer end of the radially extending portion, a retainer (e.g. 15) having a first axially extending portion (e.g. 23 that is contacted to 27 at initial installation process, hence having an interference contact between surface of 23 and 27) slidably mounted to the second axially extending ring portion of the sleeve in a radial interference fit and having a second portion (e.g. portion embedded into 16 and left of numeral 15 in figure 5), the first axially extending portion having a smaller diameter than the second portion of the retainer (diameter is smaller as measured from centerline shown in figures), a seal (e.g. 17) mounted to the retainer and engaging the first axially extending ring portion of the sleeve and the retainer portion is disengaged from the sleeve during assembly of the sleeve on to the first member (this would be the case since the member 23 and 27 are out of contact when fully assembled). Furthermore the unitized pinion seal is capable of being mounted to first and second members.

Regarding claim 2: The first member is an axial companion flange and the second member is a carrier/bearing cage (intended use limitations, the first and second members can be these types of elements as claimed in claim 2).

Regarding claims 3-5: The sleeve is adapted to install to the first member with a radial interference fit such that the radial interference fit of the seal to the sleeve creates a greater axial retention load than an axial installation load created by the interference fit of the sleeve relative to the first member (intended use and the invention of Angelo is capable of this since the invention has all the structural limitations claimed by applicant in claim 1). The seal retainer includes a first retainer ring (e.g. 27) engaging the sleeve prior to assembly of the unitized pinion seal to the first member. The retainer portion includes a second retainer ring (e.g. 22) engaging the seal body.

11. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Romero et al (US. 5,186,472).

Romero discloses a unitized pinion seal comprising a sleeve (e.g. sleeve having 24) including an outer surface having a ramp portion (e.g. ram portion on 24 between two cylindrical portions) disposed between an axially extending forward cylindrical portion (e.g. portion that is in contact with 48) and an axially extending rear cylindrical portion (e.g. rear cylindrical portion in contact with 42), wherein the axially extending forward cylindrical portion has a smaller diameter than the axially extending rear cylindrical portion (e.g. as seen in figure), a seal (e.g. 40) supported by a retainer (e.g. retainer having 36) which includes a first axially extending portion (e.g. 50) which is mounted to an axially extending surface (e.g. axial surface of 54 that contacts 50) of the sleeve in a radial interference fit and the retainer including a second portion (e.g. portion 18) and

the seal including a first seal lip (e.g. lip of 48) engaging the axially extending forward cylindrical portion and a second seal lip (e.g. 42) engaging the axially extending rear cylindrical portion.

Response to Arguments

12. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments filed 11/24/08 have been fully considered but they are not persuasive. Applicants' argument that Romero does not disclose the smaller diameter forward cylindrical portion and a second lip engaging the larger diameter rear cylindrical portion is not persuasive because Romero teaches these limitations (see above rejection).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. P./
Primary Examiner, Art Unit 3676

/Vishal Patel/
Primary Examiner, Art Unit 3676